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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,802	07/18/2005	Guenter Farin	E7900.2002/P2002	1166
24998	7590	10/18/2007		
DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			EXAMINER CHEN, VICTORIA W	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,802

Applicant(s)

FARIN ET AL.

Examiner

Victoria W. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,21,23-26,34-37 and 39-47 is/are rejected.
- 7) ☒ Claim(s) 22,27-33 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to rejection of claim 20 by Cunningham et al (US 6558383 B2) have been fully considered and are persuasive. The rejection of claim 20 has been withdrawn.

Applicant's arguments with respect to rejection of claims 20 and 35 by Mackay (US 7004939 B2) have been fully considered and are persuasive. The rejection of claims 20 and 35 has been withdrawn.

Applicant's arguments filed 4/3/07 against rejection of claims 20, 21, 23, 26 and 34-37 by Fleenor (US 5306238) and claims 24, 25, 26 by Fleenor in view of Comescu (US 5836909) have been fully considered but they are not persuasive.

Regarding the rejections under 35 USC 102(b) of Fleenor, Applicant argues that the gas and current supply pipe as disclosed by Fleenor fails to supply both gas and a high-frequency current. However, as stated by Applicant (Applicant's remarks, pg. 11, ll. 16-19), the current and supply pipe [82] comprises the lumen within elements 20, 18, 28 and 30 as described in Fleenor, col. 6, ll. 21-25. As can be seen in Fig. 1, the supply pipe therefore encloses the conductive element [70] which supplies high-frequency current to electrode element [12]. Therefore, the supply pipe does in fact supply both a gas and a high-frequency current. As the conductivity of the supply pipe is not mentioned in the claim, the argument that Fleenor does not disclose the supply pipe as being conductive is considered irrelevant. Furthermore, since Fleenor discloses element [18] as encompassing the current and supply pipe [82], this refutes Applicant's argument that Fleenor fails to disclose the insulating casing tube [14,18] as surrounding the gas

and high frequency current supply pipe [82] over a longitudinal axis. Applicant further argues that Fleenor does not disclose an insulating cap configured to detachably fasten the applicator on a handle of the electrosurgical instrument. However, Fleenor clearly states that element [20] is capable of being removably fastened onto a handle of the electrosurgical instrument [col. 5, ll. 32-33]. The rejection of claims 20, 21, 23, 26 and 34-37 by Fleenor and therefore the rejection of claims 24-26 under 35 USC 103 by Fleenor in view of Comescu are upheld.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 21, 23, 26, 34-37, 39-45 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Fleenor (US Pat No 5306238). For this reference, Examiner considers the end of the instrument with the electrode tip as the proximal end, and the end of the instrument with the gas and current terminal as the distal end.

Regarding claims 20 and 26, Fleenor discloses an electrosurgical apparatus with a gas and high frequency current terminal [64, Fig. 2], a cutting electrode [12], gas and current supply pipe [82], insulating cap [20], insulating tube [14 & 18], right angle bend [25], and radially surrounding gas-sealing inhibiting device, in this case an O-ring [col. 6, ll. 26-29].

Regarding claim 21, the inhibiting device is disclosed as being located in a proximal extension of the cap [84, Fig. 1].

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Regarding claims 23 and 34, Fleenor discloses a consumption-resistant hollow cylindrical, partially outwardly projecting insert, made of ceramic, arranged at a proximal end of the casing tube [15, col. 5, ll. 63-65].

Regarding claim 35, Fleenor discloses the electrode as being attached at a proximal end of the inside of the gas and current supply pipe [Fig. 1, col. 5, ll. 54-62].

Regarding claim 36 and 37, Fleenor discloses a fastening support pipe where the pipe adjusts the electrode for achieving optimal surrounding gas flow [col. 5, ll. 66-68, col. 6, ll. 1-20].

Regarding claim 39, Fleenor discloses a supply pipe configured to communicate a gas flow and high frequency current [82], an electrode [12], an insulating member [14 & 18] and a sealing member [col. 6, ll. 26-29].

Regarding claim 40, Fleenor discloses the insulating member is configured for displacement between a first position covering the electrode [Fig. 1] and second position not covering the electrode [Fig. 2].

Regarding claim 41, Fleenor discloses the insulating member is an insulating tube configured for sliding engagement with an outer circumference of the supply pipe [Fig. 1].

Regarding claim 42, Fleenor discloses the seal is a fluid-proof seal [col. 6, ll. 6-9].

Regarding claim 43, Fleenor discloses an insulating cap [20] configured for sliding engagement with an outer circumference of said supply pipe [col. 5, ll. 32-33].

Regarding claim 44, Fleenor discloses the supply pipe [82] extends through the insulating cap [20] [col. 6, ll. 21-25].

Regarding claim 45, Fleenor discloses the insulating cap is configured to cooperate with the insulating member to limit displacement relative to the supply pipe [col. 3, ll. 59-68].

Regarding claim 47, Fleenor discloses the electrode [12] is attached to the supply pipe via an inner surface of said supply pipe [Fig. 2].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleenor in view of Cosmescu (US Pat No 5836909). Fleenor discloses everything as previously described, except for a radially surrounding groove for accommodating an inhibiting device on the current supply pipe. Cosmescu teaches the use of an O-ring to prevent gas from escaping during a surgical procedure [142, Fig. 5a], wherein the O-ring is located in a groove around a supply pipe. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use the O-ring as taught by Cosmescu to modify the invention disclosed by Fleenor in order to prevent gas from escaping during a surgical procedure. Cosmescu does not teach the groove being on the casing tube. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to put the groove on the casing tube because Applicant has not disclosed that putting the groove on the casing tube provides an advantage over a groove on the supply pipe. One of ordinary skill in the

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art would have expected Applicant's invention to perform equally as well with either location of the groove because both locations perform the same function of preventing gas leakage and providing a friction fit. Therefore, it would have been an obvious matter of design choice to modify Cosmescu to obtain the invention as specified in claim 25.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fleenor in view of Stoddard et al. (US 6602249 B1). Fleenor discloses the invention as claimed, but fails to teach the supply pipe formed of an electrically conductive material. Stoddard teaches an electrosurgical gas delivery instrument with an electrode [32] and a gas and high frequency supply pipe [40] formed with a layer [49] of conductive material [Fig. 4] in order to eliminate the electrical potential in the gas and high frequency supply pipe to protect the surgeon [col. 5, ll. 57-62]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to form the supply pipe with an electrically conductive material in order to eliminate the electrical potential in the gas and high frequency supply pipe to protect the surgeon.

Allowable Subject Matter

Claims 22, 27-33 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victoria W. Chen whose telephone number is (571) 272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/VWC/
10/7/07


HENRY M. JOHNSON, III
PRIMARY EXAMINER